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09/804,819	03/13/2001	Robert David Piotrowski	7984	2044

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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL BUSINESS CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/804,819
Filing Date: March 13, 2001
Appellant(s): PIOTROWSKI ET AL.

MAILED
AUG 24 2006
GROUP 3700

S. Robert Chuey

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 3, 2003 appealing from the Office action mailed January 28, 2003.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65, and 66 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,568,763

KUNZLER

10-1996

(10) Grounds of Rejection

The following new ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-66 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while enabling for directing a consumer to one or more types of beverage items, does not reasonably provide enablement for directing a consumer to purchase one or more of the beverage products. The specification, which contains subjective criteria, does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected to purchase a beverage from the variety of selections.

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

On October 26, 2005, the USPTO published Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility. See:

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf

This guideline details a procedure for determining patent eligible subject matter. As to claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66, the first step in this process is whether the claims fall within one of enumerated categories. In the immediate application, the claims are drawn to a process - a “method of directing a consumer to one or more types of coffee from a plurality of options” - and meets this step. However, the analysis does not end here. The next step is whether a judicial exception (abstract ideas, laws of nature, natural phenomenon) is provided in the claim. In the immediate application, the claims (in particular independent claims 1, 20, and 53) clearly includes one of the judicial exceptions in that “whereby the consumer identifies and purchases one or more products” is nothing more than an abstract idea based on the subjective criteria in the specification. While abstract ideas alone are not eligible, the claim as a whole must be analyzed to determine whether it is for a particular application of the abstract idea. For claims including such excluded subject matter to be eligible, the claim must be for a practical application of the abstract idea, law of nature, or natural phenomena. To satisfy the requirement of a practical application, the claimed invention must:

(1) transform an article or physical object to a different state or thing; if no transformation, then

(2) the claimed invention must produce a useful, concrete, and tangible result.

Regarding (1) above, the claims do not provide a transformation or reduction of an article to a different state or thing. The method of “directing a consumer to one or more types of coffee” does not transform an article or physical object to a different state or thing. Accordingly,

one must then consider whether the claimed invention produces a useful, concrete, and tangible result.

(a) Useful Result

For an invention to be “useful” it must satisfy the utility requirement of section 101. The USPTO’s official interpretation of the utility requirement provides that the utility of the invention has to be (i) specific, (ii) substantial and (iii) credible. See MPEP 2107. It can be argued that the claim does not provide a useful result in that the claim does not actually solve a problem. Simple inspection with no result thereafter does not appear to be useful.

(b) Tangible Result

The tangible requirement does not necessarily mean that a claim must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. However, the tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process claim must set forth a practical application of that 101 judicial exception to produce a real world result.

Regarding the tangible result requirement, the claim clearly does not provide a practical application for reasons similar to that discussed above. For example, once inspected, how is this then applied?

(c) Concrete Result

Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. In other words, the process must have a result that can be substantially repeatable or the process must substantially produce the same

result again. Resolving this question is dependent on the level of skill in the art. For example, if the claimed invention is for a process which requires a particular skill, to determine whether the process is substantially repeatable will necessarily require a determination of the level of skill of the ordinary skilled artisan.

Regarding the concrete result requirement, the claim does not provide a result that can be assured in that the result cannot be substantially repeatable and the process cannot substantially produce the same result again. Simply directing a consumer to one or more types of coffee or beverage does not preclude that the consumer will purchase the coffee or selected beverage. Thus, there is no clear, cut and “concrete” evidence that applicant’s claimed invention will perform as claimed.

In view of the above analysis, applicant’s claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 are a process which includes a judicial exception therein. Upon review of the claim as a whole, there is no transformation nor does the claim produce a useful, concrete, and tangible result. Accordingly, the claim is non-statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 16, 17, 20-30, 32, 33, 53-63, 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunzler ('763).

Kunzler discloses a method of controlling an automatic coffee machine (9), wherein the automatic coffee machine has a plurality of selectors (1-7) for indicating desired parameters such as the size of coffee desired and the type of coffee desired (e.g. decaffeinated). Kunzler discloses that "this allocation is only an example, and that it may be fashioned for other types of coffee and other beverages, such as hot chocolate, hot water for tea, etc." (see col. 3, lines 30-43). Inherently, the type of beverage to be used in the machine would determine the particular indicia provided on the selectors (which could be presented in any format as desired by the end user, to include a guide/chart and/or modified slide rule). In figure 1, the seven selectors located on the front operating side (8) of the machine (9) provide a guide/chart (see col. 2, lines 24-28 and col. 3, lines 30-31).

(11) Response to Argument

Appellant traverses the 35 U.S.C. §101 rejections of the claims, which state that the requirement of the claimed invention being "concrete" has not been satisfied. Appellant alleges that the present claims define a method that produces a "useful, concrete, and tangible result", which is, the consumer purchases a coffee product that is best suited to their lifestyle and tastes. As stated in the above rejections, the present claims fail to meet all of the requirements of 35 U.S.C. §101. The claims must provide a "useful, concrete and tangible result". As stated above, the claims fail to provide a "concrete" result since there is no guarantee

or assurance that the claimed Multiple Self-Characterization Cues will, in fact, direct a consumer to one or more types of coffee. There are many factors that help a consumer to determine what type of coffee to select (e.g., taste preference, health related concerns, social environment/climate, etc.). It cannot be conclusively determined that the particular Cues as set forth by appellant, will direct a consumer to purchase a particular type of coffee. The result of appellant's claimed invention is speculative and it would require undue experimentation to produce the concrete result. The claims merely manipulate an abstract idea of coffee selection without producing a "useful, concrete and tangible result".

Appellant argues that the selection and purchase of coffee is the "concrete" result. The examiner respectfully agrees that the ultimate purchase of coffee provides a "concrete" result; however, the examiner maintains that it cannot be conclusively determined that, in light of appellant's claimed method using the Multiple Self-Characterization Cues, the consumer purchases the coffee based upon the cues set forth by the present invention. It is conceivable that the consumer has a predilection for a particular type of coffee and despite the presence of the Multiple Self-Characterization Cues as set forth by appellant, the consumer would purchase the coffee of his/her choosing based upon his/her prior purchases.

The examiner, therefore, maintains that the presently claimed invention fails to meet the requirements of 35 U.S.C. 101.

Appellant argues that Kunzler fails to disclose varying the type of coffee selected by a consumer. Appellant further states that Kunzler teaches a standard coffee brewer

wherein the strength and quantity of the coffee is varied based on a consumer's selected criteria. Kunzler discloses a method of controlling an automatic coffee machine 9, wherein the automatic coffee machine has a plurality of selectors 1-7 for indicating desired parameters such as the size of coffee desired and the type of coffee desired (e.g. decaffeinated). As seen in figure 1, the seven selectors located on the front operating side of the machine carry icons in the shape of varying sized coffee cups provide the user with a quick guide for selecting the desired coffee. While Kunzler does disclose varying the quantity of the coffee selected (as set forth in col. 3, lines 30-43) using the selectors, Kunzler also discloses that "this allocation is only an example, and that it may be fashioned for other types of coffee and other beverages, such as hot chocolate, hot water for tea, etc." Inherently, these other types of coffee could include parameters that vary the roast, grind, flavor, country of origin, etc., depending on the result desired and the information to be conveyed by the manufacturer of the coffee machine. The examiner maintains that Kunzler does indeed disclose the presently claimed invention of directing a consumer to one or more types of coffee from a plurality of options using selectors (cues) for the reasons as previously stated above.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M Henderson', is written over a horizontal line.

Mark Henderson


Examiner/ Art Unit 3722

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:


Fred Schmidt

Director/ Tech. Ctr. 3700

Conferees:


Monica S. Carter

Examining SPE/ Art Unit 3722

Greg Vidovich 
Examining SPE/ Tech. Ctr. 3700


Tom Hughes
Examining SPE/Tech. Ctr. 3700

THE PROCTOR & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER – BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224